

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-63 and 65-70. Claim 64 was canceled in a previous communication. While Applicants do not necessarily agree with the grounds of rejection provided in the Office Action, by the present Response, Applicants amend claims 1, 11, 19, 30, 31, 38, 49, and 63 to further clarify the claimed subject matter. Upon entry of the amendments, claims 1-63 and 65-70 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

### **Rejections under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-15, 17-34, 36-46, 48-53, and 62-70 under 35 U.S.C. § 103(a) as unpatentable over Andrew (U.S. Patent No. 6,763,139) in view of Taubman (U.S. Patent No. 6,778,709) and the JPEG 2000 Part I Final Committee Draft Version 1.0 entitled "Coding of Still Pictures" (on the ISO cover page) or "JPEG 2000 Image Coding System" (on the original draft version) (ISO/IEC JTC 1/SC 29/WG 1 N1646, hereafter referred to as "the N1646 reference"). The Examiner also rejected dependent claims 54-61 under 35 U.S.C. § 103(a) as unpatentable over Andrew and Taubman in view of Cooke, Jr. et al. (U.S. Patent No. 6,574,629). Additionally, the Examiner rejected dependent claims 16, 35, and 47 under 35 U.S.C. § 103(a) as unpatentable over Andrew and Taubman in view of Sodagar et al. (U.S. Patent No. 6,157,746).

As a preliminary matter, Applicants note that the rejections of the independent claims are based at least in part on the newly cited N1646 reference. While Applicants believe the record clearly indicates that the Examiner has considered the present claims in view of the N1646 reference, Applicants respectfully request that the Examiner cite the N1646 reference in a PTO-892 for the sake of clarity in the record. Further, it appears

that the rejections of dependent claims 16, 35, 47, and 54-61 in the Office Action do not include reference to the N1646 document, although the rejections of their respective independent claims do, in fact, rely on this reference. For at least the reasons below, Applicants believe that all of the claims of the instant application are allowable over the cited references. Should the Examiner, however, maintain the rejections of claims 16, 35, 47, and 54-61, Applicants respectfully request clarification of these rejections in any future Office Action.

### ***Legal Precedent***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

### ***Omitted Features of the Independent Claims***

Turning now to the present claims, it appears that the Andrew, Taubman, and N1646 references collectively fail to disclose each element of amended independent

claims 1, 19, 31, 38, 49, and 63. For instance, independent claim 1, as amended, recites “providing a reference option to the client and receiving from the client an input indicative of a desire to reference mark the area of interest” and “reference marking the area of interest in response to the client input to facilitate later retrieval and/or analysis of the marked area of interest.” *See, e.g., id.* at page 48, line 24 – page 49, line 1; FIG. 24A (illustrating a reference option 666 and marking 668) . Independent claims 19, 31, 38, 49, and 63 also contain recitations generally directed to providing a reference option to a client that facilitates selective reference marking of an area of interest upon client request. Because it is believed that the Andrew, Taubman, and N1646 references fail to disclose such elements, Applicants respectfully submit that the cited references fail to support a *prima facie* case of obviousness with respect to the present independent claims.

In the Office Action, the Examiner stated:

Andrew further teaches that the method comprises:

...

--reference marking the area of interest to facilitate later retrieval and/or analysis of the marked area of interest; (column 22, lines 25-39; The information of the accumulated history of client requests associated with each area of interest is a marking of the area. Rate of retrieval and/or quality of retrieved image of an area of interest is inherently marked with the request history. The marking facilitates retrieval by a client [of] a preferred area.)

Office Action mailed October 19, 2007, pp. 6-7. Upon review of the Andrew and Taubman references, it appears (and Applicants will assume for the purposes of this Response) that the Examiner intended to refer to column 22, lines 25-39 of the *Taubman* reference, rather than the Andrew reference.

Applicants do not necessarily agree with the Examiner’s assertion that maintaining an accumulated history of all client requests, as generally suggested by Taubman, can be reasonably equated with “reference marking” a particular area of

interest as previously recited in the instant claims. As noted above, however, Applicants have amended the claims in the interest of further clarifying the recited subject matter and of advancing examination of the instant application. Even assuming, for the sake of argument, that storing an accumulated client request history could be equated with reference marking of an area of interest, the Taubman reference does not appear to disclose, teach, or even hint at any client interactivity in a reference marking process, let alone “providing a reference option to the client and receiving from the client an input indicative of a desire to reference mark the area of interest” or “reference marking the area of interest in response to the client input to facilitate later retrieval and/or analysis of the marked area of interest,” as recited by independent claim 1 (and generally recited in the other independent claims). Further, the Andrew and N1646 references do not appear to obviate such omissions.

Because the Andrew, Taubman, and N1646 references apparently fail to disclose each and every element, the cited references do not appear to establish a *prima facie* case of obviousness with respect to independent claims 1, 19, 31, 38, 49, and 63, or their respective dependent claims. For at least these reasons, Applicants respectfully request withdrawal of this rejection under 35 U.S.C. § 103 and allowance of claims 1-15, 17-34, 36-46, 48-53, 62, 63, and 65-70.

***Deficiencies of the Rejections of Claims 16, 35, 47, and 54-61***

Applicants note that each of claims 16, 35, 47, and 54-61 depends from one of independent claims 1, 31, 38, or 49. As discussed above, the Andrew, Taubman, and N1646 references collectively fail to disclose each element of these independent claims. Further, the Cooke, Jr. et al. and Sodagar et al. references do not appear to obviate the deficiencies of the Andrew, Taubman, and N1646 references. As a result, dependent claims 16, 35, 47, and 54-61 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter separately

recited in these dependent claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 16, 35, 47, and 54-61.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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